



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,654	10/26/2001	Cheryl L. Neofytides	020375-000220US	1069
20350 7590 11/09/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER AKINTOLA, OLABODE	
			ART UNIT	PAPER NUMBER
			3691	
			MAIL DATE	DELIVERY MODE
			11/09/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/046,654	Applicant(s) NEOFYTIDES ET AL.	
	Examiner OLABODE AKINTOLA	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-37,39-41 and 50-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-37,39-41 and 50-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/9/2009 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 25-29, 31-37, 39-41 and 50-53 are rejected under 35 U.S.C. 102(c) as being anticipated by Levchin et al (US 7089208) (hereinafter referred to as "Levchin").

Re claim 25: Levchin teaches a method for automatically transferring credit between a stored value fund maintained in a database and a handler using a wide-area computer network, the method comprising: establishing a stored value fund at the database and associating the stored value fund with a user, and from which a desired amount is to be transferred from the user to a payee (col. 8, lines 31-46, col. 15, line 9 through col. 16, line 40); receiving, at a server computer system having a payment controller, automated transfer information from the wide-area computer network coupled to a user associated with the stored value fund, the automated transfer information comprising handler information on one or more handlers, including one of the handlers that is selected by the user as a default handler (col. 2, lines 37-44, col. 7, lines 12-15, col. 16, lines 21-23); determining at the payment controller the handler for an automated transfer (col. 2, lines 37-39); determining at the payment controller the direction of the automated transfer with respect to the stored value fund (col. 7, lines 12-15); determining at the payment controller an amount for the automated transfer (col. 5, lines 62-66, col. 9, lines 5-8); automatically transferring the automated transfer amount between the stored value fund in the database and the handler determined for use for the automated transfer (col. 5, lines 62-66); after the automated transfer, determining if there are sufficient funds in the stored value fund to make the transfer of the desired transfer amount to the payee (col. 10, lines 41-44); and if there are not sufficient funds in the stored value fund to make the transfer of the desired transfer amount, transferring additional funds from the default handler to the stored value fund (col. 10, lines 41-

Art Unit: 3691

44).

Re claim 26: Levchin teaches a step of determining if a transfer period has expired (col. 4, lines 11-12; col. 14, line 64 through col. 15, line 2).

Re claim 27: Levchin teaches a step of determining if a threshold amount is crossed (col. 5, lines 62-66).

Re claim 28: Levchin teaches wherein: the determining the amount step comprising a step of determining the difference between the threshold amount and a balance of the stored value fund; and the difference is equal to the transferred amount (col. 5, lines 62-66).

Re claim 29: Levchin teaches wherein the amount is included in the automated transfer information (col. 4, lines 9-11).

Re claim 31: Levchin teaches wherein the server computer system comprises a plurality of computers coupled together by a computer network (figure 1).

Re claim 32: Levchin teaches, wherein the handler includes at least one of a bank, a credit card company, a debit card company, an agent location, a stored value fund, an airline mileage program, a gift certificate issuer, an electronic gift certificate issuer, and a money order issuer

Art Unit: 3691

(col. 5, lines 62-66).

Re claim 33: Levchin teaches wherein the amount corresponds to at least one of: currency, monetary value, airline mileage, promotional program points, gift certificate credit, and commodities (col. 4, lines 34-41).

Re claim 34: Levchin teaches, wherein the automatically transferring step comprises at least one of the following steps: transferring the amount with a bank account; transferring the amount with a credit card or debit card; transferring the amount in a check or money order; transferring the amount to another's stored value fund; transferring the amount to an agent location chosen by the user; transferring a telegram or a greeting card with a check or money order for the amount; and transferring an electronic greeting card with an electronic payment notification for the amount embedded therewith (col. 7, lines 12-15).

Re claim 35: Levchin teaches steps of: retrieving a trigger condition that initiates the automatically transferring step; and determining when the trigger condition is satisfied (col. 5, lines 62-66).

Re claim 36: Levchin teaches, wherein the trigger condition includes at least one of: a credit balance in the stored value find meeting a threshold; and a period of time expiring (col. 5, lines 62-66).

Art Unit: 3691

Re claim 37: Levchin teaches, wherein the user, the handler and the server computer system are remotely located with respect to each other (figure 1).

Re claim 39: See claims 25 and 35-36 analyses, *supra*.

Re claim 40: See claims 25, 28 and 35-36 analyses, *supra*.

Re claim 41: See claims 25, 32 and 35-36 analyses, *supra*.

Re claim 50: Levchin teaches, wherein the handler for the automated transfer and the default handler are different handlers (col. 16, lines 21-24).

Re claim 51: Levchin teaches, after the automated transfer and any transfer of additional funds from the default handler, converting the funds in the stored value fund from one form of monetary value to a different form of monetary value (col. 16, lines 21-24, col. 4, lines 32-41).

Re claim 52: Levchin teaches wherein the funds in the stored value funds are converted from currency to promotional points (col. 16, lines 21-24, col. 4, lines 32-41).

Re claim 53: Levchin teaches wherein the funds are converted from a currency of one country to a currency of a different country (col. 16, lines 21-24, col. 4, lines 32-41).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Levchin.

Re claim 30: Levchin does not explicitly teach a step of electronically notifying the user of the automated transfer, wherein the electronic notification includes at least one of a web page, an instant message, an e-mail message, a pager message, and a wireless phone message. Official notice is hereby taken it is old and well known in the fund transfer art to provide notification to user of the system. It would have been obvious to one of ordinary skill in the art at the time of the invention to include this feature in Levchin teachings. One would have been motivated to do so in order to confirm to the user that the value has been successfully transferred.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Olabode Akintola/

Examiner, Art Unit 3691